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on August 29, 2005

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08 / 29 / 05
Date of Signature

PATENTS

UNUS #99-D023-A-TR
CASE #J6571(C)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No.: 000201
Applicant: Ross
Attorney docket no.: J6571(C)
Serial No. 10/771,645
Filed: February 4, 2004
For: INDICIA FOR CONTAINERS

Group: 3722
Examiner: Willmon Fridie, Jr.
Englewood Cliffs, New Jersey 07632
August 29, 2005

PRE-APPEAL BRIEF REQUEST FOR REVIEW
According to OG Notice dated July 12, 2005

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Rejection mailed on June 3, 2005, please enter the following Pre-Appeal Brief Request for Review. No amendments are being filed with this request. A Notice of Appeal accompanies this submission.

Remarks/Arguments begin on page 2 of this paper.

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REMARKS

Reconsideration and withdrawal of the examiner's final rejection under 35 U.S.C. §103 is respectfully requested in view of the following remarks.

35 USC §103

The examiner has rejected claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Marks (U.S. 4115939) in view of Moore (U.S. 2305890), asserting the following:

Marks disclose a container assembly having a front partially transparent label (12) having graphics and a rear label (14) located directly underneath said front label with complimentary graphics thereon. Marks lack the disclosure of complimentary graphics located on the container surface directly underneath said front label. Moore teaches that it is well known in the art to use complimentary graphics (13) on a container wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the rear label of Marks with complimentary graphics located on the container surface directly underneath said front label in the manner as taught by Moore to reduce the cost of the assembly.

In regard to claims 3 and 4, the examiner takes Official Notice of the use of pressure sensitive acrylic adhesive and a substrate of polypropylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these claimed features since the use of such is old and well known in the art. Further there would appear to be no inventive advantage by the use of such.

In regard to claim 5, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to form the assembly such that the claimed removal force is needed, since applicant has not disclosed that this solves any stated problem or is for any particular purpose. Applicants respectfully point out the following errors in these rejections whereby a prima facie case under 35 USC § 103 has not been properly established.

To establish prima facie obviousness under 35 U.S.C. 103, all the claim limitations must be taught or suggested by the prior art. MPEP 1504.03 (II) or 706.02 (J). Among other deficiencies, the combination of Marks and Moore cited by the examiner does not show or suggest at least one wall containing graphics and a label removably affixed directly to said wall and said graphics. Marks discloses a glass bottle containing a light permeable liquid that has a front and rear label section thereon to view the cooperative relationship. The front and rear label sections are on opposed sides of the bottle in Marks (see column 2, line 59 to line 61), which is at variance with the examiner's description of what Marks discloses. This arrangement is not the same as the "one wall" in the claim that contains both graphics and the label removably affixed to said wall. Moore does not remedy the deficiencies of Marks with respect to this claim element as Moore also discloses a bottle that has complimentary graphics on opposed walls and not the same wall (see fig. 3 where sailboat 13 is positioned on obverse side 11 and seascape 14 is positioned on reverse side 12). Therefore, applicants respectfully assert that a prima facie case of obviousness under 35 U.S.C. 103 has not been established in the instant case with respect to Marks and Moore. The examiner further admits that in his action mailed June 3, 2005, "Marks lacks the disclosure of complimentary graphics located on the container surface directly underneath said front label" (see page 2).

Applicants note that official notice is taken of the use of pressure sensitive acrylic adhesive and the substrate of polypropylene with respect to claims 3 and 4. However, since claims 3 and 4 ultimately depend from claim 1 and the prima facie case of obviousness has not been made out for claim 1, official notice does not remedy the deficiencies of Marks and Moore with respect to claims 3 and 4.

With respect to the examiner's assertion that the applicant has not disclosed that the claimed removal force of claim 5 is needed, applicants respectfully direct attention to the specification on page 2, lines 24 to 28, where it is stated that a reworkable pressure sensitive adhesive constitutes a preferred embodiment of the invention. This embodiment is recited in claim 1, element c, wherein it is a requirement that the wall and said graphics adhered to said wall remain intact when said label is removed. It is well known to those skilled in the art that a reworkable adhesive is the kind of adhesive that fails within the adhesive layer (adhesive failure) and not within the substrate layers that are adhered to the adhesive (cohesive failure). This failure mechanism provides the reworkable adhesive with its name "reworkable" and prevents damage to the underlying walls and graphics adhered to the walls that are adjacent to

the adhesive. Thus, claim 5 recites a preferred embodiment of the removal force that characterizes a reworkable adhesive.

In his response on page 3, mailed on June 3, 2005, the examiner asserts that applicant has not disclosed the problem solved by the claimed removal force. On the contrary, applicants respectfully refer to the specification on page 2, lines 12-15, where the goal of having an attractive package is obtained by allowing the consumer to remove "informative label graphics".

This act is rendered possible by the use of a reworkable adhesive as a permanent adhesive would prevent easy removal of the label by the consumer.

Further, in the examiner's response on page 3, the examiner asserts that "...the graphics adhered to the wall would inherently remain intact once the label is removed" but offers no proof beyond this assertion. On the contrary, applicants respectfully assert that the adhesion of inks forming an image or graphics to a substrate often fails when force is applied to the surface of that image such as with an adhesive film pressed onto the image and then pulled away. This oftentimes results in the partial or complete destruction of the image, graphics or text.

CONCLUSION

In light of the above remarks, applicants respectfully submit that a proper rejection under 35 USC § 103(a) has not been made. Accordingly, reversal of the Final Rejection is appropriate and is courteously solicited.

If a telephone interview would facilitate prosecution of the application, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,



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